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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,580	04/14/2004	Richard Paul Ejzak	29250-002031/US	6232

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EXAMINER

BALAOING, ARIEL A

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/823,580	Applicant(s) EJZAK, RICHARD PAUL	
	Examiner Ariel Balaoing	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Response to Arguments

2. Applicant's arguments filed 04/27/2006 have been fully considered but they are not persuasive.

Regarding claim 1, the applicant argues "Claim 1 recites transferring a packet switched call between a mobile station and an end point; claim 1 also recites that a bearer path is established between the mobile station and the end point, if a call transfer request is received. In other words, a packet switched call may be transferred to another network, for example, a circuit switch network. In addition, as claim 1 recites, even if the packet switched call is transferred, the transfer is still between the mobile station and the end point" and "Applicant's submit that Bos et al. discloses transferring a packet switched call between packet switched multimedia terminal 1 and a termination unit 4 to circuit switched terminal 5 and the termination unit 4. Accordingly, Bos et al. fails to disclose all the features of claim 1" (see page 7 and 8 of the remarks of the remarks); the examiner respectfully disagrees. Claim 1 recites the limitation *establishing a bearer path if a call transfer request associated with the mobile station is received*. As can be seen on paragraphs 50-53, packet switched multimedia terminal 1 can be a packet-switched UMTS multimedia terminal (in which case coupling 15 is a packet-switched multimedia **mobile connection**) establishes a connection with terminating unit 4 (i.e. end point of said claim). It can be seen on paragraph 54 that a

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transfer is performed and a connection path is established without terminating unit being disconnected.

3. In response to applicant's arguments, the recitation *transferring a packet switched call between a mobile station and an end point* has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). It is further noted that the preamble recites a method of transferring a packet switched call, wherein the packet switched call is between a mobile station and an end point. Therefore the packet switched call is between a mobile and an end point, while the transferring is of the call itself.

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-10, 16-21 are rejected under 35 U.S.C. 102(e) as being anticipated by BOS et al (US 2004/0008669 A1).

Regarding claim 1, BOS discloses a method of transferring a packet switched call, the packet switched call being between a mobile station and an end point

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(abstract), the method comprising: establishing a bearer path if a call transfer request associated with the mobile station is received (abstract; paragraph 7-10, 52-54; call transfer request is initiated by the network or mobile user).

Regarding claim 2, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the call transfer request is a call request including an identifier provided by the mobile station that identifies the call request as a call transfer request (paragraph 52-54; invitation is sent after obtaining number using SIP REFER).

Regarding claim 3, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the identifier is a public identifier provided for use by mobile stations to request call transfer of an ongoing packet switched call (paragraph 52-54; invitation is sent after obtaining number using SIP REFER).

Regarding claim 4, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the identifier is a unique identifier associated with the mobile station for use in requesting call transfer of an ongoing packet switched call (paragraph 52-54; invitation is sent after obtaining number using SIP REFER).

Regarding claim 5, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the unique identifier is a public telecommunication number assigned to the mobile station for use in the second network (paragraph 52-54; MSISDN number).

Regarding claim 6, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the call request is a SIP INVITE request (paragraph 52, 74; invitation is sent to the gateway using SIP protocol after SIP REFER message).

Regarding claim 7, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the establishing step comprises: sending a call control request to the end point requesting agreement to transition the packet call controller from a call control agent for a first call control path from the first network to the end point to a call control agent for a second call control path from the second network to the end point (paragraph 65, 82; server 2 instructs terminating unit that all data should be sent to gateway 7).

Regarding claim 8, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the establishing step further comprises: setting up the bearer path at the packet call controller as the call control agent for the second call control path (paragraph 65, 82).

Regarding claim 9, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the control request is a SIP re-INVITE request (paragraph 82).

Regarding claim 10, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the call transfer request is a SIP INVITE request (paragraph 52, 74; invitation is sent to the gateway using SIP protocol after SIP REFER message).

Regarding claim 16, BOS discloses a method of transferring a packet switched call carried over a first network to a circuit switched call carried over a second network (abstract), comprising: sending a call transfer request associated with a mobile station involved in the packet switched call if a call origination request for a circuit switched call is received (abstract; paragraph 7-10, 52-54; call transfer request is initiated by the network or mobile user).

Regarding claim 17, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the call transfer request is a call request including an identifier provided by the mobile station that identifies the call request as a call transfer request (paragraph 52-54; invitation is sent after obtaining number using SIP REFER).

Regarding claim 18, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the identifier is a public identifier provided for use by mobile stations to request call transfer of an ongoing packet switched call (paragraph 52-54; invitation is sent after obtaining number using SIP REFER).

Regarding claim 19, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the identifier is a unique identifier associated with the mobile station for use in requesting call transfer of an ongoing packet switched call (paragraph 52-54; invitation is sent after obtaining number using SIP REFER).

Regarding claim 20, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the unique identifier is a public telecommunication number assigned to the mobile station for use in the second network (paragraph 52-54; MSISDN number).

Regarding claim 21, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the call request is a SIP INVITE request (paragraph 52, 74; invitation is sent to the gateway using SIP protocol after SIP REFER message).

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over BOS et al (US 2004/0008669 A1) in view of KALLIO et al (US 2004/0190498 A1).

Regarding claim 11, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the establishing step comprises: receiving a SIP INVITE request (paragraph 52-54, 65, 82); determining whether the SIP INVITE request requests transfer of the packet switched call on the first network to a circuit switched call on the second network (paragraph 52-54, 65, 82); and setting up the bearer path between the end point and the second network when the determining step determines that the SIP INVITE request does request transfer (paragraph 52-54, 65, 82). However, BOS does not expressly disclose wherein the SIP

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INVITE includes a request URI; and wherein the determination is based on the request URI. KALLIO discloses wherein the SIP INVITE includes a request URI; and wherein the determination is based on the request URI (paragraph 50-52). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify BOS to include a request URI within the SIP INVITE, as taught by KALLIO, as both systems relate to the transferring of packet based communication to circuit based communication. This is beneficial in that as the URI can be used to determine all participants of the call.

Regarding claim 12, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, BOS does not expressly disclose wherein the determining step determines that the SIP INVITE request does request transfer when the Request URI is a public identifier provided for use by mobile stations to request call transfer of an ongoing packet switched call. KALLIO discloses wherein the determining step determines that the SIP INVITE request does request transfer when the Request URI is a public identifier provided for use by mobile stations to request call transfer of an ongoing packet switched call (paragraph 50-52). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify BOS to include a request URI within the SIP INVITE, as taught by KALLIO, as both systems relate to the transferring of packet based communication to circuit based communication. This is beneficial in that as the URI can be used to determine all participants of the call.

Regarding claim 13, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, BOS does not expressly disclose wherein the determining step determines that the SIP INVITE request does request transfer when the Request URI is a unique identifier associated with the mobile station for use in requesting call transfer of an ongoing packet switched call. KALLIO discloses wherein the determining step determines that the SIP INVITE request does request transfer when the Request URI is a unique identifier associated with the mobile station for use in requesting call transfer of an ongoing packet switched call (paragraph 50-52). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify BOS to include a request URI within the SIP INVITE, as taught by KALLIO, as both systems relate to the transferring of packet based communication to circuit based communication. This is beneficial in that as the URI can be used to determine all participants of the call.

Regarding claim 14, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the establishing step further comprises: sending a SIP re-INVITE request to the end point requesting agreement to transition the packet call controller from a call control agent for a first call control path from the first network to the end point to a call control agent for a second call control path from the second network to the end point (paragraph 65, 82); and wherein the setting up step is performed by the packet call controller as the call control agent for the second call control path (paragraph 65, 82).

Regarding claim 15, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses further comprising: serving as a proxy for the packet switched call prior to the receiving step (paragraph 50, 64; P-CSCF); accumulating information regarding the packet switched call while serving as the proxy (paragraph 52-54, 65; detection of a continuation problem inherently requires accumulating information regarding the packet switched call); and wherein the determining step determines that the SIP INVITE request does request transfer based on at least the accumulated information (paragraph 52-54). However, BOS does not expressly disclose wherein the URI is used for determination of transfer request. KALLIO discloses wherein the URI is used for determination of transfer request (paragraph 50-52). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify BOS to include a request URI within the SIP INVITE, as taught by KALLIO, as both systems relate to the transferring of packet based communication to circuit based communication. This is beneficial in that as the URI can be used to determine all participants of the call.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ariel Balaoing whose telephone number is (571) 272-7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 AM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


GEORGE ENG
SUPERVISORY PATENT EXAMINER

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